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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,991	03/31/2005	Ernest R Fernandez	461391/0037	5330
7590 Steven B Pokotilow Stroock & Stroock & Lavan 180 Maiden Lane New York, NY 10038			EXAMINER DANG, HUNG XUAN	
			ART UNIT 2873	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			01/16/2007	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/529,991

Applicant(s)

FERNANDEZ ET AL.

Examiner

Hung X. Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment filed on 10/20/06 has been entered.

Claims Rejection Under 35 USC – 112-1st Paragraph

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not support for the newly added language “a **prescription lens therein having lower degree of wrap than the frame.**” in claim 12.

Claims Rejection Under 35 USC - 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Gaspari** (4,021,103).

Gaspari discloses ophthalmic mounting arrangement comprises a frame 12 having a lens mounting means 13 therein; a prescription adapter ring 21 removably mounted in said lens mounting means 13, said adapter ring 21 comprising a prescription lens 22 therein; wherein said mounting means 13 has a higher wrap than said prescription lens (see at least figures 1, 4 and the related disclosure.)

Allowable Subject Matter

4. Claims 1-11 are allowed.

Reasons For Allowance

5. The following is an Examiner's Statement of Reasons for Allowance:

The prior art fails to teach a combination of all the claimed features as present in independent claim 1, which include a rear portion having a first curvature that generally matches the curvature of the wrap type eyewear, said rear portion comprising a mounting means for maintaining said adapter ring to said eyewear; and a front portion comprising a lens mounting means for mounting a prescription lens onto the adapter ring, said lens mounting means having a second curvature that is less than said first curvature.

Response to Applicant's Argument

6. Applicant's arguments filed 10/20/06 have been fully considered but they are not persuasive.

Re applicant's arguments on page 8, wherein the applicant argues that "Applicants respectfully submit that Gaspari fails to teach or suggest "a high-wrap frame having a high-wrap mounting means" as recited in claims 12-13. Rather, Gaspari is directed to a frame having a "relatively large radius of curvature, and in the extreme may be planar." The larger the radius of curvature, the less the curvature and degree of wrap. Thus, the frame of Gaspari does not teach, but rather teaches away from the "high-wrap" frame and mounting means as claimed by independent claim 12."

This argument is not persuasive because "high-wrap frame" expression is nothing more than a frame that wraps around the lens, thus figures 1, 4 and 6 of Gaspari clearly show that a frame 12 having a lens mounting means 13 therein; a prescription adapter ring 21 removably mounted in said lens mounting means 13, said adapter ring 21 comprising a prescription lens 22 therein. Therefore the claimed invention does not distinguish over Gaspari prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

1/07

A handwritten signature in black ink, appearing to read 'Hung Dang', with a stylized, looped end.

HUNG DANG

PRIMARY EXAMINER

TC 2800